

REMARKS

This is in response to the non-final Office Action mailed October 1, 2010. Claims 1, 2, and 4-14 are currently pending. Claim 6 is amended.

Reconsideration of the Application is respectfully requested in view of the amendments and comments provided herein

The Office Action

Claims 1, 2, and 4-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0854157 to McBain (hereinafter “McBain”) and further in view of U.S. Patent App. Pub. 2004/0023050 to Kia (hereinafter “Kia”).

The Subject Claims Patentably Distinguish Over the References of Record

Independent claim 1 is directed to a coating composition, comprising (a) a saturated aliphatic polyester urethane acrylate; (b) a hydroxyalkyl (meth)acrylate; (c) a vinyl-substituted aromatic compound; (d) a polyacrylate ester of an alkylene polyol wherein the alkylene group has from 2 to 30 carbon atoms; (e) a (cyclo)aliphatic (meth)acrylate, wherein the (cyclo)aliphatic group is saturated and comprises from 1 to 50 carbon atoms; and (f) optionally, a peroxide initiator, wherein, for every 100 parts by weight saturated aliphatic polyester urethane acrylate, the amount of the (cyclo)aliphatic (meta)acrylate is from 0.5 to 10 parts by weight. Applicant respectfully submits that McBain and Kia do not, individually or in combination, teach or suggest the limitations as provided in the present claims.

The presently claimed composition exhibits significantly improved adhesion properties compared to the composition disclosed in McBain. This improved adhesion is due, at least in part, to a reduced amount of (cyclo) aliphatic (meta) acrylate. Specifically, McBain teaches that the aliphatic or cycloaliphatic (meth)acrylate is present in an amount of 20 to 100 parts by weight, desirably from 35 to 90 parts by weight (page 3, lines 43-45), which is significantly higher than the amount comprised in the composition presently claimed. McBain relates to a top-coat in-mold coating having high gloss and excellent appearance. The present composition performs a different role, specifically, that of a less-expensive base coat formulation that typically uses a high gloss clear top-coat on top of it. (See page 7, lines 21-26 of the original

documents). Thus, the composition of McBain and the formulation in accordance with the presently claimed invention clearly relate to different technical applications.

Moreover, the present inventors unexpectedly found that the formulations in accordance with the presently claimed invention have better adhesion properties to substrates compared to the compositions of McBain. A description of the favorable properties of the compositions in accordance with the present application may be found on page 7, lines 14-19 of the original documents, which, since subject to a declaration signed by the inventors, provides sufficient rebuttal to *prima facie* obviousness. Applicant submits that there is no teaching or suggestion in McBain to a composition having the features recited in claim 1 and the advantages associated therewith.

Although the Examiner acknowledges that McBain fails to teach or suggest a coating composition comprising 0.1 to 15 parts by weight (cyclo) aliphatic (meta) acrylate, the Examiner submits that Kia teaches the use of alkyl (meth)acrylates in a range of 10 to 50% by weight for the purpose of acting as a diluent, and it would have been obvious for one skilled in the art to modify the composition taught by McBain to limit the (cyclo)aliphatic(meth)acrylate content as claimed for the purpose of providing a diluent as taught by Kia. Applicant respectfully disagrees.

Kia is directed to a pigmented gel coat that may include diluents **in addition to those found in the resin.** (See [0052]). Kia explains that the diluents include at least one alkyl acrylate or alkyl methacrylate monomer at about 10 to 50% by weight. Similarly, McBain also includes aliphatic or cycloaliphatic (meth)acrylate in the coating composition; however, McBain teaches that the aliphatic or cycloaliphatic (meth)acrylate is present in an amount of 20 to 100 parts by weight, desirably from 35 to 90 parts by weight and is utilized to react with the polyester urethane acrylate and form a **thermoset resin.** (See col. 3, lines 39-58). Accordingly, if a diluent such as that taught in Kia was incorporated into the coating composition of McBain, the diluent would not replace the aliphatic or cycloaliphatic (meth)acrylate already present and utilized in forming the thermoset resin of McBain, but would be incorporated **in addition to** the already present material. McBain does not teach the inclusion of a diluent, therefore based only on the explicit teaching in Kia that the diluent is in addition to that found in the resin, one skilled in the art would have no motivation to replace the aliphatic or cycloaliphatic (meth)acrylate of McBain with the aliphatic or cycloaliphatic (meth)acrylate diluent of Kia. Therefore, since the minimum amount of aliphatic or cycloaliphatic (meth)acrylate in McBain is 20 parts by weight, the

combination of Kia's diluent and McBain's (cyclo)aliphatic (meth)acrylate that to forms the thermoset resin **necessarily exceeds** the presently claimed amount of (cyclo)aliphatic (meth)acrylate.

For at least the aforementioned reasons, Applicant respectfully submits that the subject claims patentably distinguish over the references of record. As such, the rejection of independent claim 1, along with claims 2, and 4-14 that depend therefrom, should be withdrawn.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1, 2, and 4-14) are now in condition for allowance.

Respectfully submitted,

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Date



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